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Paper No. 23

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**OFFICE OF PETITIONS**

In re Application of  
Terwilliger et al.  
Application No. 10/035,083  
Filed: December 28, 2001  
Atty Docket No. WORLD-01000US1  
SRM

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: DECISION ON APPLICATION FOR  
: PATENT TERM ADJUSTMENT  
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This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705," filed November 15, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) of zero (0) days be corrected to include an applicant delay of twenty-nine (29) days, not one hundred fifty-three (153) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the notice of allowance is zero (0) days, including a period of reduction of 29 days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On August 11, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 0 days. On November 15, 2004, applicants timely submitted the instant application for patent term adjustment<sup>1</sup>. Applicants state that the period of adjustment of 19 days should not have been reduced by 124 days for filing of an IDS after a reply had been filed. See § 1.704(c)(8). Applicants submit that no delay should be attributed to applicants for submission of the IDS because the IDS was submitted within 30 days of receipt and knowledge of an International Search Report. See § 1.704(d).

Applicants state that the patent issuing from this application is not subject to a terminal disclaimer.

As to the submission of the IDS, pursuant to 37 CFR § 1.704(c)(8), the submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, is a

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<sup>1</sup> PALM records show that the Issue Fee was also received on November 15, 2004.

failure to engage in reasonable efforts to conclude prosecution. It is undisputed that after filing a response on May 14, 2003, on September 15, 2003, applicants filed an Information Disclosure Statements (IDS). The record does not support a conclusion that the IDS was expressly requested by the examiner.

However, the record reveals that the IDS included a \$ 1.704(d) statement. Thus, it is concluded that the filing of the September 15, 2003 will not cause a reduction of the PTA.

Applicants are reminded that \$ 1.704(d) was revised, effective May 24, 2004, as follows:

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

This revision requires that the statement include the language "each item of information contained in the information disclosure statement was first cited ..." for the exception to apply. See 69 FR 21704, Apr. 22, 2004.

In view thereof, the determination of patent term adjustment at the time of the mailing of the notice of allowance is 0 days, including 19 days of Office delay and 29 days of applicant delay.

Receipt of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

The application is being forwarded to the Office of Patent Publication for timely issuance of the patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

*Karin A. Ferriter*

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Office of Patent Legal Administration  
Office of Deputy Commissioner  
for Patent Examination Policy

Enclosure: Copy of REVISED PAIR Screen